

REMARKS

The Examiner has indicated that claims 63 and 92 are withdrawn from consideration since they are directed to detecting changes in the expression of levels of inhibin instead of the elected invention of detection of inhibin protein levels. The word “expression” has been removed from claim 63. Accordingly, this claim is now directed to the elected invention and should be considered. Claim 92 has been withdrawn.

Claims 58, 60-62, 69-91, 93-99 stand rejected under 35 USC 112, first paragraph, as not being enabled by the specification. Specifically, the Examiner asserts that the claims are only enabled in relation to determining whether or not a mammal does or does not have prostate cancer. The Examiner states that the specification does not enable screening to determine who is “predisposed to develop prostate cancer.” In order to progress the prosecution of this application, the claims have been amended to remove reference to “predisposition to developing prostate cancer.” This amendment renders this rejection moot. However, applicants reserve the right to later seek claims directed to screening to determine who is “predisposed to develop prostate cancer.”

The Examiner also rejects claims 83 and 95 for not including the essential step of comparing inhibin levels such that the down-regulation and or absence of inhibit protein in the cancerous samples is observed. Claim 83 has been amended to recite “wherein a down-regulation of said inhibin protein level in said biological sample relative to the inhibin protein level of a normal mammal is indicative of said mammal having developed prostate cancer.” Similarly, claim 95 has been amended to recite “..... detecting binding of said antibody to determine a level of said inhibin protein in said biological sample, and comparing said level determined with a level known to be indicative of a normal human, wherein a down-regulation of said inhibin protein level in said biological sample relative to the inhibin protein level of a normal human is indicative of said human having developed prostate cancer.” Accordingly, this rejection of claims 83 and 95 should be withdrawn.

In addition, the Examiner has rejected claims 76 and 86 for reciting “dimmer” instead of “dimer”, claim 83 for reciting for “know” instead of “known”, and claim 86 for reciting “wherein level” instead “wherein the level.” These errors have been corrected. Accordingly, the rejection of these claims should be withdrawn.

Finally claims 70, 71 and 73 have been rejected under 35 USC 112, second paragraph. Specifically, claims 70 and 71 have been rejected for not providing antecedent basis for “the change or “said change.” These two claims have been cancelled. Accordingly, the rejection of these two claims is now moot. Claim 73 has been rejected for failing to provide antecedent basis for “said screening process.” This claim has been amended to recite “said screening” as suggested by the Examiner.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 229752000800.

Dated: December 22, 2005

Respectfully submitted,

By

Jonathan Bockman

Registration No.: 45,640

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7769